

SERIAL NO. 09/986,982

DOCKET NO. 1293.1272

REMARKSINTRODUCTION:

In accordance with the foregoing, claims 17, 20, 37, and 55 have been amended.

No new matter is being presented, and approval and entry of the foregoing amendments are respectfully requested.

Claims 1-28 and 30-58 are pending and under consideration. Reconsideration is requested.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action at pages 2-3, the Examiner rejects claims 17-20, 26-28, 37, 39, and 55 under 35 U.S.C. §102 in view of Mistretta (U.S. Patent No. 5,548,571). This rejection is respectfully traversed and reconsideration is requested.

On page 5 of the Office Action, the Examiner notes that holes h of Mistretta are disposed on a top side of the cartridge. By way of review, Mistretta discloses a carrier 30 that is removed from a caddy 10 when inserted in a disk drive as shown in FIG. 1. As such, even assuming arguendo that the holes h are disposed on a top surface of the carrier 30, there is no disclosure that the top surface is above or covering the recording surface of the disk. In addition, since Mistretta relies upon the caddy 10 to protect the recording surface, there is no disclosure that the carrier 30 includes a mechanism that protects the recording surface.

In contrast, claim 17 recites, among other features, a disk cartridge including "a case to accommodate the information recording medium, the case having a first side disposed above or below and extending across at least a portion of a recording surface of the information recording medium" and "identification units disposed on the first side of said case." As such, it is respectfully submitted that Mistretta does not disclose or suggest the invention recited in claim 17.

For similar reasons, it is respectfully submitted that Mistretta does not disclose or suggest the invention recited in claims 37 and 55.

Additionally, Mistretta discloses a disk drive having a transmitter T which emits a light beam to be received at a receiver R. A carrier 30 having the holes h and holding a disk passes into the disk drive in a direction A. Where no hole h exists as the carrier 30 passes into the disk drive, the light is not received at the receiver R. Where the holes h exist, the receiver R is illuminated and a signal is received at a CPU. (Col. 4, line 54 to col. 5, line 28, col. 7, lines 12-40; FIGs. 4, 6, and 7). However, since Mistretta utilizes a light beam, Mistretta does not suggest that the transmitter T or the receiver R contacts the carrier 30.

not in
claim
17

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In contrast, claim 20 recites, among other features, "said identification units are detectable by contact with a common tip of the probing portion." As such, it is respectfully submitted that Mistretta does not disclose or suggest the invention recited in claim 20.

Lastly, Examiner asserts on pages 3 and 6 of the Office Action that Mistretta inherently includes a tray and that the tray inherently includes a guide groove as recited in claim 39. By way of review, as shown in FIGs. 1 and 6, Mistretta discloses that the disk drive receives the carrier 30 through a drive entrance using the pinch rollers R1, R2. Mistretta does not disclose or suggest that the disk drive includes a tray that receives and moves the carrier 30. Further, since the pinch rollers R1, R2 are used, there is no need for a tray in order to introduce the carrier 30 through the opening. Further, since the transmitter T and receiver R directly access the holes h as shown in FIG. 6, there is no suggested need for a groove in such a tray.

While the Examiner relies upon the legal theory of inherency to disclose both a tray and a tray having a guide groove as recited in claim 39, it is noted that the Examiner has not provided evidence as to why Mistretta necessarily discloses both features. Generally, where the Examiner relies upon the theory of inherency, the Examiner is required to provide extrinsic evidence that the features are necessarily present in the reference. As noted in MPEP 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (emphasis in original). Since the Examiner has not provided evidence that the device shown in FIG. 6 or otherwise disclosed in Mistretta necessarily discloses a tray and a tray including a guide groove, it is respectfully submitted that the Examiner has not provided sufficient evidence to rely on Mistretta inherently disclosing such features as set forth in the Office Action.

In contrast, claim 39 recites, among other features, "a tray to receive the disc cartridge, said tray including a guide groove to receive said probing portion." As such, it is respectfully submitted that Mistretta does not disclose or suggest the invention recited in claim 39.

Claims 18, 19, and 26-28 are deemed patentable due at least to their depending from claim 17.

On pages 3-4 of the Office Action, the Examiner rejects claims 17-20, 26-28, 30, 55, and 56 under 35 U.S.C. §102(b) in view of Uwabo et al. (U.S. Patent No. 5,940,255). The rejection is traversed and reconsideration is requested.

Among other features, the Examiner asserts on page 3 of the Office Action that type identifier holes 97, 117, 119, large-capacity identifier hole 89, and switch 137 or 141 of Uwabo et al. correspond to the identification units and probing portion as recited in claim 17.

By way of review, claim 17 recites, among other features, "identification units disposed

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on the first side of said case to be sequentially detected by the probing portion." In contrast, Uwabo et al. discloses a disc drive 121 having a large capacity detecting switch 137 at a position corresponding to the large capacity identifier hole 89, and a first type detecting switch 139 at position corresponding to the type identifier hole 97. A small capacity detecting switch 141 is disposed at a position corresponding to a 2MB identifier hole 57. In addition, a second type detecting switch 143 is at a position corresponding to the type identifier hole 117, and a third type detecting switch 145 is at a position corresponding to the type identifier hole 119. The on-off conditions of the switches 137, 139, 143, and 145 is used to identify the disk 111 when in the position as shown in FIGs. 11B and 11C. (Col. 9, lines 28-64; FIG. 11A, 11B). However, while Uwabo et al. discloses positioning the switches 137, 139, 141, 143, and 145 such that each detects a corresponding one of the holes 57, 89, 97, 117, and 119, there is no suggestion that one of the switches 137, 139, 141, 143, or 145 recognizes another of the holes, or the one of the switches 137, 139, 141, 143, or 145 detects a sequence of holes as opposed to detecting the one hole disposed at the position of the one switch. Therefore, it is respectfully submitted that Uwabo et al. does not disclose or suggest "identification units disposed on the first side of said case to be sequentially detected by the probing portion" as recited in claim 17.

For similar reasons, it is respectfully submitted that Uwabo et al. does not disclose or suggest the invention recited in claims 20, 30, 55, and 56.

Additionally, Uwabo et al. discloses that the on/off states of the switches 137, 139, 143, and 145 are used to identify the type of disks. The on/off states of the switches 137, 139, 143, and 145 are disclosed as being based on whether the corresponding holes 89, 97, 117, and 119 are positioned in a predetermined location relative to the switches 137, 139, 143, and 145. Thus, the holes 89, 97, 117, and 119 are detected while the case 115 of the disk 111 is stationary in the disk drive 121 as shown in FIGs. 11B and 11C. (Col. 9, lines 28-50; FIGs. 11A and 11B). However, there is no disclosure that the disk 111 is or should be moving relative to the switches 137, 139, 143, and 145 in order for the disk type to be detected.

In contrast, claim 30 recites, among other features, "identification units disposed on said case to be sequentially detected by the probing portion of the apparatus to produce a predetermined sequence of information to determine a type of the information recording medium" where "the sequence of the information is produced by a relative motion between said identification units and the probing portion." As such, it is respectfully submitted that Uwabo et al. does not disclose or suggest the invention recited in claim 30.

For similar reasons, it is respectfully submitted that Uwabo et al. does not disclose or suggest the invention recited in claims 55 and 56.

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Claims 18, 19, and 26-28 are deemed patentable due at least to their depending from claim 17.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 4-5, the Examiner rejects claim 38 under 35 U.S.C. §103 in view of Mistretta and Uwabo et al. This rejection is respectfully traversed and reconsideration is requested.

The Examiner relies on Mistretta as disclosing the features of claim 38, but notes that Mistretta does not disclose an identification unit disposed on a side of the disk cartridge. In order to cure this deficiency, the Examiner relies on FIGs. 11A through 12B of Uwabo et al. to suggest that the identification units should be moved to a side of the disk cartridge. In order to make the combination, the Examiner asserts that one of ordinary skill in the art would have been motivated to move the holes h from a top of the carrier 30 as shown in Fig. 4 of Mistretta to instead be notches 155, 157, 159 as shown in FIGs. 12A and 12B of Uwabo et al. since doing so would allow for a large number of identification units to be used.

However, even assuming arguendo that the Examiner is correct in that the use of the notches 155, 157, 159 allows for a greater number to be used, it is noted that using the notches 155, 157, 159 disclosed in Uwabo et al. would not allow for the use of the through holes h disclosed in Fig. 4 of Mistretta. Since Mistretta relies upon the through holes to allow light to pass through the carrier 30 between the transmitter T and receiver R as shown in FIG. 6, the use of notches 155, 157, 159 as suggested in Uwabo et al. would block such a light beam and therefore prevent detection of the notches in the manner suggested by Mistretta. Further, it is unclear as to whether through holes could extend width-wise through the carrier 30 past the disc in Mistretta so as to allow the holes h to be moved to a side of the carrier 30 instead of being in the orientation shown in FIG. 4.

In evaluating whether the prior art suggests changing a design of a primary reference, the suggested change cannot render the primary reference inoperative. Specifically and as noted in MPEP 2143, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." It is respectfully submitted that the movement of through holes h to a side of the carrier 30 in the manner suggested by the Examiner would render the device shown in FIG. 6 inoperative, and therefore prevent detection in the manner suggested by Mistretta. Therefore, it is respectfully submitted that there is insufficient evidence of a motivation to change the carrier 30 to have the notches 155, 157, 159 of Uwabo et al. since the

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combination would be inoperative such that there is no suggestion to make the combination of Mistretta and Uwabo et al. applied against claim 38 as set forth in the Office Action.

STATUS OF CLAIMS NOT REJECTED:

On page 5 of the Office Action, the Examiner allows claims 1-16, 21-25, 31, 31-36, 40-54, 57, and 58.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, it is respectfully submitted that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
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on 9 April, 2004

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Date: 9 April
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